

Application No. 10/828,548
Response dated September 29, 2005
Reply to Restriction Requirement of September 29, 2005

REMARKS

Applicant elects Group IV, claims 177-184, with traverse. A Restriction Requirement was mailed for the instant case on February 4, 2005. A second Restriction Requirement was mailed on September 29, 2005.

I. The Examiner fails to provide an adequate rationale for issuing a second restriction requirement

MPEP § 706.04 provides that:

Full faith and credit should give to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something new.

The Examiner has not identified any clear error in the restriction requirement mailed February 4, 2005 action or knowledge of other prior art. The only rationale the Examiner states for issuing a second restriction requirement is that it was issued "upon further consideration." The Examiner determined that the elected Group I, claims 56-100, 120, 122, and 139-184, contains multiple patentably distinct inventions.

II. Some claims are not divided into any restriction group

The Examiner has further divided elected Group I into new Groups I through IV. Applicant respectfully points out that claims 74-84 and 86 of original Group I have been omitted from new Groups I through IV. Thus, claims 74-84 and 86 are not divided into any restriction group.

III. Restriction to Groups I and II is improper

The Examiner is requested to consider rejoining new Groups I and II for prosecution in the same application. As shown in the following table, some claims are divided into both new Group I and new Group II.

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Claims of Group I	Claims of Group II
56	56
57	57
58	58
59	59
60	
61	
	62
	63
	64
	65
66	
67	67
68	68
69	69
70	70
71	71
72	72
73	73
85	85
87	87
88	88
89	89

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Claims of Group I	Claims of Group II
90	90
91	
92	
	93
	94
	95
	96
97	
98	98
99	99
100	100
139-152	
	153-173

The Examiner is requested to consider rejoining Group I with Group II for prosecution in the same application. Group I consists of claims 56-61, 66-73, 85, 87-92, 97, 98-100, and 139-159; and, Group II consists of claims 56-59, 62-65, 67-73, 85, 87-90, 93-96, 98-100, and 153-173. The result of the restriction is that claims 56-59, 67-90, and 98-100 have been restricted into two groups, *i.e.*, Group I and Group II. Election of Group I and prosecution of claims 56-61, 66-73, 85, 87-92, 97, 98-100, and 139-159 in one application and election of Group II and prosecution of claims 56-59, 62-65, 67-73, 85, 87-90, 93-96, 98-100, and 153-173 in different application might result in claims 56-59, 67-90, and 98-100 issuing in two separate patents for the same invention.

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Under 35 U.S.C. § 121, an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION." (See MPEP § 803.01, emphasis found in the original.) It is respectfully submitted that it is self-evident and incontrovertible that the restriction of claims 56-59, 67-90, and 98-100 into Groups I and II is improper.

IV. Restriction between species of a generic claim

The Examiner has effectively required restriction between two species of generic claim 1, i.e., (1) antibodies which bind to the N-terminus of beta-amyloid; and, (2) antibodies which bind the C-terminus of beta-amyloid.

The Examiner maintains the inventions of Groups I and II are distinct because that are unrelated. Thus, the only justification or statutory authority put forth by the Restriction Requirement for refusing to examine claim 1 is 35 U.S.C. § 121. However, there is nothing therein to excuse a refusal to examine an elected invention or a generic claim reading thereon.

As a preliminary matter, alleging that a particular claim represents multiple patentably distinct inventions is a *de facto* rejection of the patentability of the claim, because the claim cannot issue as drafted. As the C.C.P.A. noted:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the

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applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

See, In Re Weber, Soder and Boksay 198 USPQ 328, 331 (C.C.P.A. 1978). *See also, In Re Haas* 179 USPQ 623, 624, 625 (*In Re Haas I*) (C.C.P.A. 1973) and *In Re Haas* 198 USPQ 334-337 (*In Re Haas II*) (C.C.P.A. 1978).

Moreover, it has been held that an Examiner may not reject a particular claim on the basis that it represents independent and distinct inventions. *See, In Re Weber, Soder and Boksay, Supra*. The courts have ruled that the statute authorizing restriction practice, i.e., 35 U.S.C. § 121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. *See, In Re Weber, Soder and Boksay, In Re Haas I* and *In Re Haas II*. In the cases set forth above, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *In Re Weber, Soder and Boksay*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-- no matter how broad, which means no matter how many independently patentable inventions may fall within it.

See, In Re Weber, Soder and Boksay at 334.

Instead of imposing a restriction requirement on a single claim, the Office may limit initial examination to a reasonable number of species encompassed by the claim. *See, 37 C.F.R. § 1.146*. This practice strikes an appropriate balance between the concerns of the patent office regarding administrative concerns and unduly burdensome examination, and the clear constitutional and statutory rights of an inventor to claim an invention as it is contemplated, provided the dictates of 35 U.S.C. § 112 are complied with. *See, the MPEP at 803.02. See also, In Re Wolfrum* 179 USPQ 620 (C.C.P.A. 1973) and *In re Kuehl* 177 U.S.P.Q. 250 (C.C.P.A. 1973). Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution, nor does it force an applicant to

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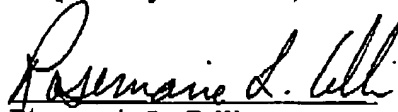
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file multiple divisional applications which are incapable of capturing the intended scope of the application.

V. Conclusion

Based on the foregoing, Applicant requests that the restriction requirement be vacated in favor of the restriction requirement mailed February 4, 2005. In the alternative, Applicant requests that new Groups I and II be rejoined and a species election be issued.

Respectfully submitted,



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